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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): D/A 0836 (15-8-3190)

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on November 14, 2005

Signature: Lynette E. James

Typed or printed name: Lynette E. James

Application Number	Filed
09/732,024	December 8, 2000

First Named Inventor: Paula S. Newman, et al.

Art Unit	Examiner
2144	Tammy T. Nguyen

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant/inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [ ] attorney or agent of record. Registration number _____.
- [X] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 Reg. No. 47,248

John F. Guay
Signature

John F. Guay
Typed or printed name

Telephone number

November 14, 2005
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

[X] *Total of 1 forms are submitted.

PATENT
Docket No.: **D/A0836 (1508/3190)**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	:	Paula S. Newman and Michelle Q. Wang Baldonado	Examiner: Tammy T. Nguyen
Serial No.	:	09/732,024	Art Unit: 2144
Cnfrm. No.	:	1622	
Filed	:	December 8, 2000	Date: November 14, 2005
For	:	METHOD AND APPARATUS FOR PRESENTING EMAIL THREADS AS SEMI-CONNECTED TEXT BY REMOVING REDUNDANT MATERIAL	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Date 11/14/05

This is a Pre-Appeal Brief Request For Review from the rejection set forth in the Final Office Action dated July 13, 2005. Claims 1, 3-10, 12-18, and 20-27 have been finally rejected, and a Notice of Appeal and Request Form are timely filed concurrently herewith. Accordingly, this Pre-Appeal Brief Request For Review is being timely filed and should be considered. Any fees required for extensions of time and any fees for the net addition of claims are hereby authorized to be charged to Deposit Account No. 19-2380.

Claims 1, 3-10, 12-18, and 20-27 are currently rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,484,196 to Maurille (hereinafter referred to as Maurille) in view of U.S. Patent No. 6,044,395 to Costales et al. (hereinafter referred to as Costales). This rejection is traversed as being based on references that neither teach nor suggest all of the features recited in independent claims 1, 10, 18, and 26, and dependent claims 3-9, 12-17, 20-25, and 27.

The invention is directed to a method for presenting email threads. In particular, the logical components of each message in a thread are identified, the relationships between the messages in the thread are determined using the logical components, and a document is generated based upon the determined relationships. In addition, *any logical components that are identified in each of the messages in the thread are removed during the generating step* so that the generated document does not include the redundant logical components.

More specifically, claim 1 recites, *inter alia*,

> wherein any logical components that are identified in each of the messages in the thread are removed during the generating step so that the generated document does not include the redundant logical components.

Similarly, claim 10 recites, *inter alia*,

> wherein the processor is adapted to remove any logical components that are identified in each of the messages in the thread so that the generated medium does not include the redundant logical components.

Moreover, claim 18 recites, *inter alia*,

> information that removes any logical components that are identified in each of the messages in the thread so that the generated medium does not include the redundant logical components.

Finally, claim 26 recites, *inter alia*,

> wherein any logical components that are identified in each of the messages in the thread are removed during the generating step so that the generated medium does not include the redundant logical components.

Maurille and Costales fail to teach or suggest at least these features. Nonetheless, in the rejection, the Examiner asserts that Maurille teaches the invention as claimed in claims 1, 10, 18, and 26. (Fig. 3B, col. 3, lines 40-65, and col. 10, lines 20-30). However, the Examiner correctly states that Maurille fails to teach or suggest wherein any logical components that are identified in each of the messages in the thread are removed during the generating step so that the generated document does not include the redundant logical components. In an attempt to overcome this deficiency, the Examiner asserts that Costales teaches that any logical components that are identified in each of the messages in the thread are removed during the generating step so that the generated document does not include the redundant logical components. (Fig. 5A, and col. 5, line 65, to col. 6, line 40).

In general, Maurille relates to a system and method that provides integrated combinations of threaded instant messages, open display bulletin boards, private bulletin

boards, threaded e-mail, explicit acknowledgment of messages, and conferencing, whisper and talk modes. The system can be implemented in any Internet-based computer network, including the Internet, intranets and extranets. As another example, when implementing private bulletin boards, the server application creates private message boards for each user that allow each user to access only those messages in which he participates (as sender or recipient). When a user acknowledges a message, the server application closes the thread including the message and permits no additional activity in that thread. (Abstract). As admitted by the Examiner, Maurille fails to teach or suggest to remove identified redundant logical components from a generated document or medium as recited in the independent claims.

Costales relates to a method wherein "information common to multiple e-mail messages (called common content "chunks") is separated from the individual e-mail messages before transmission." (Abstract). In addition, Costales discloses that the chunks are "reassembled into a complete e-mail message at the receiving site." (Col. 3, lines 28-33). Thus, Costales discloses a method for reassembling content "chunks" identified in existing messages into a new message. While Costales suggests dividing messages into chunks and identifying chunks that are used in multiple e-mail message, thus "redundant", there is no suggestion whatsoever in Costales to *remove* any of the identified, redundant "chunks" when generating the new message. To the contrary, the example in Costales referenced by the Examiner on page 3 of the Office Action clearly shows a content chunk being used redundantly, which is directly contrary to, and explicitly *teaches away* from, the purpose of the present invention. In particular, Content Chunk 1 includes the text "THIS IS THE FIRST LINE OF CONTENT", which is repeated three times in Fig. 5B, which shows the final generated message. (See Figs. 4-5, col. 4, lines 10-44, and col. 5, line 65, to col. 6, line 42).

While Costales appears to disclose the extraction of common chunks of messages, there is simply no suggestion whatsoever to remove the identified common chunks from the generated message. Thus, like Maurille, Costales clearly fails to disclose or suggest to remove identified redundant logical components from a generated document or medium as recited in the independent claims.

Therefore, the rejection is materially deficient as each and every element of independent claims 1, 10, 18, and 26 is neither taught nor suggested. Even when combined, the combined disclosures of Maurille and Costales fail to render obvious the claimed features

of independent claims 1, 10, 18, and 26. Dependent claims 3-9, 12-17, 20-25, and 27 are also allowable by virtue of their dependency on claims 1, 10, 18, and 26 described above, and also on their own merits.

In addition, with respect to dependent claims 4-6, 13-14, and 21-22, the Examiner asserts that Maurille teaches the use of a weighted finite-state machine. (Fig. 4B, col. 1, line 55, to col. 2, line 10, and col. 20, lines 15-55). With respect to claims 6, 14, and 22, Applicants note that there is no detailed explanation of the rejections in the Office Action. Accordingly, for the purposes of Appeal, Applicants herein address the Examiner's reasons for rejection for these claims in the prior Office Action of July 9, 2004, wherein the Examiner asserts that Costales teaches the use of a weighted finite state grammar, as recited in claims 6, 14, and 22. (Fig. 4, and col. 5, line 18, to col. 6, line 60).

More specifically, claim 4 recites, *inter alia*,

> decomposing each section into logical components using a weighted finite-state machine.

Similarly, claim 5 recites, *inter alia*,

> applying a weighted finite state machine to the result.

Furthermore, claim 6 recites, *inter alia*,

> building a weighted network using a weighted finite state grammar; identifying the maximally weighted path through the network; and traversing the maximally weighted path to identify the logical components of the section.

In addition, claim 13 recites, *inter alia*,

> wherein the processor is adapted to perform a top-down, recursive descent analysis to create nodes of the message tree and to analyze divided extents using a weighted finite state machine.

Also, claim 14 recites, *inter alia*,

> wherein the processor is adapted to identify the maximally weighted path through the weighted finite state machine, and to develop a sub tree by traversing the maximally weighted path.

Moreover, claim 21 recites, *inter alia*,

> information that analyzes divided extents using a weighted finite state machine.

Finally, claim 22 recites, *inter alia*,

> information that identifies a maximally weighted path through the weighted finite state machine; and information that develops a sub tree by traversing the maximally weighted path.

These features are further described, for example, from page 6, line 6, to page 7, line 30, of Applicants' Specification.

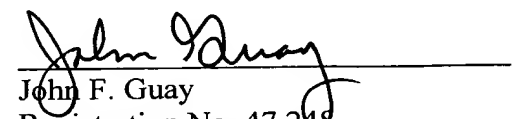
In contrast, the portions of Maurille relied upon by the Examiner relate to the limitations inherent in traditional e-mail messages (i.e. lack of features related to reaching an agreement, etc.), and the fact that e-mail messages include information that is categorized in fields, which can be updated as necessary by the server application. (col. 1, line 66, to col. 2, line 10, and col. 20, line 15-55). Similarly, the portions of Costalles relied upon by the Examiner relate to dividing an e-mail message into "chunks" as is described in detail above. (col. 5, line 18, to col. 6, line 60). However, the descriptions relied upon from these documents do not relate to the combination of specific features noted above with respect to claims 4-6, 13-14, and 21-22. Thus, neither Maurille nor Costalles would have led one of ordinary skill in the art to the use of a weighted finite state machine or a weighted finite state grammar, as is recited in the claims. Even when combined, the disclosures of Maurille and Costales fail to render obvious the claimed features of claims 4-6, 13-14, and 21-22.

Therefore, claims 4-6, 13-14, and 21-22 recite separately patentable subject matter not taught or suggested in the proposed combination of Maurille and Costalles.

For all of the above noted reasons, the Examiner has failed to establish a *prima facie* case of obviousness. Accordingly, Applicants request the rejections under 35 U.S.C. § 103(a) be withdrawn and independent claims 1, 10, 18, and 26 and dependent claims 3-9, 12-17, 20-25, and 27 be allowed to pass to issuance.

Respectfully submitted,

Date: November 14, 2005



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